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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|----------------------------------|-------------|----------------------|---------------------|------------------|
| 10/028,160 | 12/20/2001 | Ernest L. Thurber | 53661US007 | 4211 |
| 32692 | 7590 | 10/24/2003 | EXAMINER | |
| 3M INNOVATIVE PROPERTIES COMPANY | | | BERMAN, SUSAN W | |
| PO BOX 33427 | | | ART UNIT | PAPER NUMBER |
| ST. PAUL, MN 55133-3427 | | | 1711 | |

DATE MAILED: 10/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/028,160

Applicant(s)

THURBER ET AL.

Examiner

Susan W Berman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Response to Amendment and Arguments

The rejection of claims under 35 USC 112, second paragraph is withdrawn in response to the recitation of basis for the parts by weight in the amended claims.

Ho et al was applied under 35 USC 102(e) because the reference was filed earlier than the effective filing date of the instant application but not issued one year before the effective filing date of the instant application. The rejection of claims as being anticipated by Ho et al (5,702,811, filed 10-20-1995) is withdrawn. The rejection of claims as being anticipated by EP 0 486 308 is withdrawn. The rejection of claims under 35 U.S.C. 102(b) as being anticipated by Engen et al (5,551,961) is withdrawn. Applicant's argument that Ho et al, EP '308 and Engen et al disclose liquid compositions rather than a fusible powder is persuasive.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4, 5 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strong (3,925,219). See the Abstract, column 1, line 54, to column 2, line 13, column 3, lines 25-35, lines 40-44, column 3, line 60, to column 4, line 14. It would have been obvious to one skilled in the art at the time of the invention to select metal salts of fatty acids, such as zinc stearate, as the wax component, as taught by Strong in column 3, lines 25-44. It would have been obvious to one skilled in the art at the time of the invention to include a fatty acid in the powder, as taught by Strong in column 3, lines 25-44, and in examples 4 and 6. One of ordinary skill in the art at the time of the invention would have been motivated by a reasonable expectation of successfully providing a pressure-fixable developing powder because

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Strong teaches that fatty acids and metal salts of fatty acids are useful wax components having a melting or softening point in the range of about 45 °C to about 150 °C.

Allowable Subject Matter

Claims 7-9 are allowed.

Claims 2, 3, 6, 10 and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 11 would be allowable if the radiation curable binder precursor were not optional.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The disclosure of Quan (4,643,960) incorporates the disclosure of Strong '219. Ikeda et al (3,779,918) disclose molded plastic compositions comprising a thermosetting or thermoplastic resin that may be powdery and an oil or lubricant. See column 4, lines 3-26, column 4, line 64, to column 5, line 56, and Examples 17-26. The examples teach using about 20 parts by weight stearic acid in the compositions. Ikeda et al teach that the abrasion resistance of these base materials can be highly improved by using a lubricating oil mixed with specific high fatty acids or metal soaps thereof.

The following references teach fusible powder compositions wherein metal salt of fatty acids are used in parts by weight significantly less than the parts by weight set forth in the instant claims: DeRoo et al (4,4778,923), Miyamoto et al (5,721,190), Tanei et al (4,105,449), Okamoto et al (4,906,604), and Ishida et al (4,910,184).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan W Berman whose telephone number is 703 308 0040. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 703 308 2462. The fax phone number for the organization where this application or proceeding is assigned is 703 872 9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 0661.



Susan W Berman
Primary Examiner
Art Unit 1711

SB
October 18, 2003